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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,301	03/17/2005	Siegfried Gahler	VBS 0010 US	6469

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT	PAPER NUMBER
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1793

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10/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,301	Applicant(s) GAHLER ET AL.	
	Examiner David M. Brunzman	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050317</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's election with traverse of group I, claims 1-11 in the reply filed on 23 July 2008 is acknowledged. The traversal is on the ground(s) that the citation of PCT rules against this national stage application is improper, no lack of unity was required in the parent and the applicant does not agree with the characterization of the special technical feature as residing in the silver compound. This is not found persuasive because as set forth in MPEP 1893.03(d) and 37 CFR 1.499 the proper standard for making a restriction requirement in the national stage of a PCT application (371 application) is the PCT Unity of Invention standard. With respect to the absence of a lack of unity finding in the parent, the parent was prosecuted in a different national office and the decision of that office not make a lack of unity requirement does not bind this national office. With respect to the determination of the special technical feature, the special technical feature should be considered with respect to novelty and inventive step other than the provision of the compound containing silver, the claims recite only a binder soluble in a solvent. The silver compound is clearly the special technical feature.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,4,6,8,10 and 11 are rejected under 35 U.S.C. 102(a or e) as being anticipated by US 2003/0194658.

The reference teaches a coating composition comprising a silver halide, an organic silver compound, a binder and a reducing agent for silver ions. (See Abstract). The composition may include additional dyes as sensitizers, for example (See paragraph 0208). The binders are selected from a list including natural and synthetic polymers (paragraphs 0269-0270) and are used in amount falling within the scope of the instant claims (paragraph 0271).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0194658, as applied above.

Claim 5 requires that the composition further include an additional substance providing viscosity, volume, drying rate, wettability or stability to the composition. It would have been obvious to one of ordinary skill in the art to include an additive having an effect on stability, for example, on its face because it would be expected to improve stability. Claim 9 requires the addition of an adhesion-improving agent or wetting agent. It would have been obvious to one of ordinary skill in the art to add an adhesion

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improving agent because an improvement in adhesion to the coating which is intended to be permanent would be expected.

Claims 1,2,4,5,6,8 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6908728.

Column 32 of the reference teaches coating compositions for laser marking of surfaces including glass comprising gelatin, silver halide, a sensitizing dye, and a hardener (lines 21-22) and comprising an SBR latex, silver halide, organic silver, a reducing agent, a dye, an image stabilizer and a hardener (lines 44-46).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6908728, as applied above.

Claim 9 requires the addition of an adhesion-improving agent or wetting agent. It would have been obvious to one of ordinary skill in the art to add an adhesion improving agent because an improvement in adhesion to the coating which is intended to be permanent would be expected.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6908728, as applied above, in view of US 5589324.

Claim 3 requires that the composition further include a zirconium compound. US 5589324 teaches the addition a zirconium acetate to light sensitive silver halide coatings in order to increase hardness (column 11, lines 29-30). It would have been obvious to one of ordinary skill in the art to add a zirconium compound such as zirconium acetate to the composition of the primary reference because an increase in the hardness of the coating would be expected.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6908728, as applied above, in view of US 4292400.

Claim 7 recites a list of substances useful as the reducing agent. US 4292400, column 6, lines 52-53 of the secondary reference teaches that tin compounds, for example, are useful as reducing agent in silver halide photosensitive compositions. It would have been obvious to one of ordinary skill in the art to employ a tin compound as the reducing agent in the primary reference for that reason.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, Th, F, Sa; 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David M Brunsman/
Primary Examiner, Art Unit 1793

DMB